REMARKS/ARGUMENTS

Applicants respectfully request further examination and reconsideration in view of the instant response. The claims remaining in the present application are Claims 1-13, 15 and 17-19. Claims 1-13, 15, 17 and 18 are rejected. Claim 19 is allowed. Claims 1-13, 15 and 17-19 are amended herein. No new matter has been added. Support for the claim amendments can be found at least at page 34, lines 9-23.

CLAIM REJECTIONS – 35 U.S.C. §101

Claims 1-13, 15, 17 and 18

Claims 1-13, 15, 17 and 18 are rejected under 35 U.S.C. §101 "as being directed to patent-ineligible subject matter" (Decision on Appeal mailed March 2, 2010, page 4). Applicants have amended Claims 1-13, 15, 17 and 18 (and allowed Claim 19) to be directed towards patentable subject matter. For example, Claim 1 has been amended to recite "[a] computer-implemented method for... entering, by a computer system..." (emphasis added). Applicants understands *In re Bilski* (88 USPQ 2d 1385 CAFC (2008)) to hold that a process under 35 U.S.C. §101 must (1) be tied to a machine or (2) transform underlying subject matter. Applicants respectfully submit that a computer system is a machine. Therefore, Applicants respectfully submit that Claims 1-13, 15 and 17-19 are directed towards patentable subject matter, and thus overcome the rejection under 35 U.S.C. §101.

ALLOWABLE SUBJECT MATTER

The Final Office Action mailed March 24, 2008 states that "Claim 19 is allowed" (page 8). Applicants wish to thank the Examiner for indicating that Claim 19 is allowed. Applicants have amended independent Claims 1, 13 and 18 to include the allowed subject matter of Claim 19. Therefore, Applicants respectfully submit that Claims 1, 13 and 18 are allowable. Moreover, Claims 2-10, 15 and 17 that depend from Claims 1 and 13, respectively, are also allowable because they depend from allowable base claims.

CLAIM REJECTIONS – 35 U.S.C. §103

Claims 1-6 and 8-12

The Final Office Action mailed March 24, 2008, indicates that Claims 1-6 and 8-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp et al. (US 6,263,317), hereinafter referenced as "Sharp," in view of Curie et al. (US 6,871,232), hereinafter referenced as "Curie." Applicants respectfully submit that the embodiments of the present invention as recited in Claims 1-6 and 8-12 are patentable over the combination of Sharp and Curie for at least the following rationale.

Claim 1 recites an embodiment of the present invention (emphasis added):

A computer-implemented method for a first organization to do business comprising:
    entering, by a computer system, into a contractual relationship with a second organization;
    authorizing, by said computer system, said second organization to take an order from a customer, said order comprising at least one of:
        products not produced by said first organization, and services not provided by said first organization;

receiving, by said computer system, payment directly from said customer as a payment for said order taken by said second organization;

requiring, by said computer system, an organization other than said first organization to ship products not produced by said first organization to said customer;

requiring, by said computer system, an organization other than said first organization to provide services to said customer;

determining, by said computer system, a billing strategy based upon whether or not the services ordered may be completed in less than a predetermined period of time;

wherein it is determined, by said computer system, that the services ordered may not be completed in less than the predetermined period of time and further comprising

determining, by said computer system, whether the services ordered are essential to the use of hardware included on the order; and

wherein it is determined, by said computer system, that the services ordered are not essential to the use of hardware included on the order and further comprising invoicing the hardware portion of the order prior to completion of the services ordered.

Claims 2-6 and 8-12 that depend from independent Claim 1 also include these embodiments.

"As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries" including "[a]scertaining the differences between the claimed invention and the prior art" (MPEP 2141(II)). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious" (emphasis in original; MPEP 2141.02(I)). Applicants note that "[t]he prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office personnel must explain why

the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art" (emphasis added; MPEP 2141(III)).

Moreover, Applicants respectfully note that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Applicants respectfully submit that Sharp does not teach or suggest "determining, by said computer system, a billing strategy based upon whether or not the services ordered may be completed in less than a predetermined period of time; wherein it is determined, by said computer system, that the services ordered may not be completed in less than the predetermined period of time and further comprising determining, by said computer system, whether the services ordered are essential to the use of hardware included on the order; and wherein it is determined, by said computer system, that the services ordered are not essential to the use of hardware included on the order and further comprising invoicing the hardware portion of the order prior to completion of the services ordered," as claimed. Applicants understand Sharp to disclose "[a] computer system and method of operation thereof are provided that allow manufacturers and distributors of brand products to participate in the e-commerce marketplace without violating existing distribution channels" (abstract).

Moreover, Curie does not overcome the deficiencies of Sharp. Applicants understand Curie to disclose "provisioning resources from a central location via a third party resource provisioning management (RPM) service provider" (abstract). In particular, Curie does not disclose "determining, by said computer system, a billing strategy based upon whether or not the services ordered may be completed in less than a predetermined period of time; wherein it is determined, by said computer system, that the services ordered may not be completed in less than the predetermined period of time and further comprising determining, by said computer system, whether the services ordered are essential to the use of hardware included on the order; and wherein it is determined, by said computer system, that the services ordered are not essential to the use of hardware included on the order and further comprising invoicing the hardware portion of the order prior to completion of the services ordered," as claimed.

Applicants respectfully submit that the combination of Sharp and Curie, <u>as a whole</u>, does not satisfy a *prima facie* case of obviousness under 35 U.S.C. §103(a). Therefore, Applicants respectfully submit that Claim 1 is in a condition for allowance. Applicants respectfully submit that the combination of Sharp and Curie also does not render obvious the additional claimed features as recited in Claims 2-6 and 8-12 that depend on Claim 1. Therefore, Applicants respectfully submit that Claims 2-6 and 8-12 are in a condition for allowance as being dependent on an allowable base claim.

<u>Claim 7</u>

The Final Office Action mailed March 24, 2008, indicates that Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp and Curie and further in

view of Hogan (US 2001/0002464). Applicants respectfully submit that the embodiments of the present invention as recited in Claim 7 is patentable over the combination of Sharp and Curie for at least the following rationale.

Claim 7 is dependent on independent Claim 1 and includes the features of Claim 1. By demonstrating that Sharp, Curie and Hogan does not teach or suggest the features of independent Claim 1, it is also demonstrated that Sharp, Curie and Hogan does not teach or suggest the embodiments of dependant Claim 7.

The combination of Sharp and Curie does not render unpatentable the independent claims, as presented above. In particular, the combination of Sharp and Curie does not suggest or teach "determining, by said computer system, a billing strategy based upon whether or not the services ordered may be completed in less than a predetermined period of time; wherein it is determined, by said computer system, that the services ordered may not be completed in less than the predetermined period of time and further comprising determining, by said computer system, whether the services ordered are essential to the use of hardware included on the order; and wherein it is determined, by said computer system, that the services ordered are not essential to the use of hardware included on the order and further comprising invoicing the hardware portion of the order prior to completion of the services ordered," as claimed.

Moreover, Hogan does not overcome the deficiencies of Sharp. Applicants understand Hogan to disclose "a scanner-based management system and method for

efficiently monitoring and controlling the servicing of equipment using a network"
(abstract). In particular, Hogan does not disclose "determining, by said computer
system, a billing strategy based upon whether or not the services ordered may be
completed in less than a predetermined period of time; wherein it is determined, by said
computer system, that the services ordered may not be completed in less than the
predetermined period of time and further comprising determining, by said computer
system, whether the services ordered are essential to the use of hardware included on
the order; and wherein it is determined, by said computer system, that the services
ordered are not essential to the use of hardware included on the order and further
comprising invoicing the hardware portion of the order prior to completion of the
services ordered," as claimed.

Applicants respectfully submit that the combination of Sharp, Curie and Hogan,
as a whole, does not satisfy a *prima facie* case of obviousness under 35 U.S.C.
§103(a). Therefore, Applicants respectfully submit that Claim 1 is in a condition for
allowance. Applicants respectfully submit that the combination of Sharp, Curie and
Hogan also does not render obvious the additional claimed features as recited in Claim
7 that depends on Claim 1. Therefore, Applicants respectfully submit that Claim 7 is in
a condition for allowance as being dependent on an allowable base claim.

Claims 13 and 15

The Final Office Action mailed March 24, 2008, indicates that Claims 13 and 15
are rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp and further in

view of Carpenter et al. (US 6,868,401), hereinafter referenced as "Carpenter."

Applicants respectfully submit that the embodiments of the present invention as recited

in Claims 13 and 15 are patentable over the combination of Sharp and Carpenter for at

least the following rationale.

Applicants respectfully submit that Sharp does not teach or suggest "determining,

by said computer system, a billing strategy based upon whether or not the services

ordered may be completed in less than a predetermined period of time; wherein it is

determined, by said computer system, that the services ordered may not be completed

in less than the predetermined period of time and further comprising determining, by

said computer system, whether the services ordered are essential to the use of

hardware included on the order; and wherein it is determined, by said computer system,

that the services ordered are not essential to the use of hardware included on the order

and further comprising invoicing the hardware portion of the order prior to completion of

the services ordered," as claimed. Applicants understand Sharp to disclose "[a]

computer system and method of operation thereof are provided that allow

manufacturers and distributors of brand products to participate in the e-commerce

marketplace without violating existing distribution channels" (abstract).

Moreover, Carpenter does not overcome the deficiencies of Sharp. Applicants

understand Carpenter to disclose "[a] transaction processing system facilitates the

buying and selling of commodity products by establishing a single documentary record

for the transaction, requiring approval of variables introduced into the transaction. The

parties register and agree to a standard contract of terms" (abstract). In particular, Carpenter does not disclose "determining, by said computer system, a billing strategy based upon whether or not the services ordered may be completed in less than a predetermined period of time; wherein it is determined, by said computer system, that the services ordered may not be completed in less than the predetermined period of time and further comprising determining, by said computer system, whether the services ordered are essential to the use of hardware included on the order; and wherein it is determined, by said computer system, that the services ordered are not essential to the use of hardware included on the order and further comprising invoicing the hardware portion of the order prior to completion of the services ordered," as claimed.

Applicants respectfully submit that the combination of Sharp and Carpenter, as a whole, does not satisfy a *prima facie* case of obviousness under 35 U.S.C. §103(a). Therefore, Applicants respectfully submit that Claim 13 is in a condition for allowance. Applicants respectfully submit that the combination of Sharp and Carpenter also does not render obvious the additional claimed features as recited in Claim 15 that depends on Claim 13. Therefore, Applicants respectfully submit that Claim 15 is in a condition for allowance as being dependent on an allowable base claim.

Claim 17

The Final Office Action mailed March 24, 2008, indicates that Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp, Carpenter and further in view of Work et al. (US 2002/0007302), hereinafter referenced as "Work."

Applicants respectfully submit that the embodiments of the present invention as recited in Claim 17 is patentable over the combination of Sharp, Carpenter and Work for at least the following rationale.

Claim 17 is dependent on independent Claim 13 and includes the features of Claim 13. By demonstrating that the combination Sharp, Carpenter and Work does not teach or suggest the features of independent Claim 13, it is also demonstrated that the combination Sharp Carpenter and Work does not teach or suggest the embodiments of dependant Claim 17.

The combination of Sharp and Carpenter does not render unpatentable the independent claims, as presented above. In particular, Sharp does not suggest or teach "determining, by said computer system, a billing strategy based upon whether or not the services ordered may be completed in less than a predetermined period of time; wherein it is determined, by said computer system, that the services ordered may not be completed in less than the predetermined period of time and further comprising determining, by said computer system, whether the services ordered are essential to the use of hardware included on the order; and wherein it is determined, by said computer system, that the services ordered are not essential to the use of hardware included on the order and further comprising invoicing the hardware portion of the order prior to completion of the services ordered," as claimed.

Moreover, Work does not overcome the deficiencies of Sharp. Applicants understand Work to disclose "a scanner-based management system and method for efficiently monitoring and controlling the servicing of equipment using a network" (abstract). In particular, Work does not disclose "determining, by said computer system, a billing strategy based upon whether or not the services ordered may be completed in less than a predetermined period of time; wherein it is determined, by said computer system, that the services ordered may not be completed in less than the predetermined period of time and further comprising determining, by said computer system, whether the services ordered are essential to the use of hardware included on the order; and wherein it is determined, by said computer system, that the services ordered are not essential to the use of hardware included on the order and further comprising invoicing the hardware portion of the order prior to completion of the services ordered," as claimed.

Applicants respectfully submit that the combination of Sharp, Carpenter and Work, as a whole, does not satisfy a *prima facie* case of obviousness under 35 U.S.C. §103(a). Therefore, Applicants respectfully submit that Claim 13 is in a condition for allowance. Applicants respectfully submit that the combination of Sharp, Carpenter and Work also does not render obvious the additional claimed features as recited in Claim 17 that depends on Claim 13. Therefore, Applicants respectfully submit that Claim 17 is in a condition for allowance as being dependent on an allowable base claim.

Claim 18

The Final Office Action mailed March 24, 2008, indicates that Claim 18 is

rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp in view of Bremers

et al. (US 6,901,380), hereinafter referenced as "Bremers." Applicants respectfully

submit that the embodiments of the present invention as recited in Claim 18 is

patentable over the combination of Sharp and Bremers for at least the following

rationale.

Applicants respectfully submit that Sharp does not teach or suggest "determining,

by said computer system, a billing strategy based upon whether or not the services

ordered may be completed in less than a predetermined period of time; wherein it is

determined, by said computer system, that the services ordered may not be completed

in less than the predetermined period of time and further comprising determining, by

said computer system, whether the services ordered are essential to the use of

hardware included on the order; and wherein it is determined, by said computer system,

that the services ordered are not essential to the use of hardware included on the order

and further comprising invoicing the hardware portion of the order prior to completion of

the services ordered," as claimed. Applicants understand Sharp to disclose "[a]

computer system and method of operation thereof are provided that allow

manufacturers and distributors of brand products to participate in the e-commerce

marketplace without violating existing distribution channels" (abstract).

Moreover, Bremers does not overcome the deficiencies of Sharp. Applicants

understand Bremers to disclose "[a] business application integrates a company's

internal business systems with an e-commerce web site, so that company personnel can manage their business with a business application that seamlessly exports relevant, up-to-date data to a web site designed to interact with customers across the Web" (abstract). In particular, Bremers does not disclose "determining, by said computer system, a billing strategy based upon whether or not the services ordered may be completed in less than a predetermined period of time; wherein it is determined, by said computer system, that the services ordered may not be completed in less than the predetermined period of time and further comprising determining, by said computer system, whether the services ordered are essential to the use of hardware included on the order; and wherein it is determined, by said computer system, that the services ordered are not essential to the use of hardware included on the order and further comprising invoicing the hardware portion of the order prior to completion of the services ordered," as claimed.

Applicants respectfully submit that the combination of Sharp and Bremers, <u>as a whole</u>, does not satisfy a *prima facie* case of obviousness under 35 U.S.C. §103(a). Therefore, Applicants respectfully submit that Claim 18 is in a condition for allowance.

CONCLUSION

In light of the above remarks, Applicants respectfully request reconsideration of the rejected claims.

Based on the arguments presented above, Applicants respectfully assert that Claims 1-13, 15, 17 and 18 overcome the rejection of record, and therefore Applicants respectfully solicit allowance of these claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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